

## **REMARKS**

This Amendment is responsive to the Final Office Action dated May 18, 2007 (hereinafter the “Final Action”) in the above identified application. Applicants hereby respectfully request continued examination in accordance with 37 C.F.R. §1.114.

In view of the above amendments and the following remarks, we respectfully request favorable reexamination and allowance of the pending claims.

### **A. Status of the Application**

Claims **1, 8, 9, 13, 17, 53, 56, 60, 69, 71, 75, 81 and 92-95** have been amended.

Claims **96-106** have been added.

Claims **2, 3, 5-7, 10-12, 14, 26, 27, 35, 38, 65-68, 76-80 and 82-91** have been cancelled.

Claims **1, 4, 8, 9, 13, 15-25, 28-34, 36, 37, 39-64, 69-75, 81 and 92-106** are pending. Of these, claims **1, 56, 60, 69, 71, 75, 81 and 92-95** are the only independent claims (a total of 11 independent claims).

### **B. The Final Office Action**

Claims **1-25, 27-75 and 80-95** were rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

Claims **1-18, 20-23, 26-71, 75 and 80-95** were rejected under 35 U.S.C. 102(e) for being anticipated by Chen et al., U.S. Patent No. 6,741,969 B1 (hereinafter “Chen”).

Claims **19, 24, 25, 72-74** were rejected under 35 U.S.C. 103(a) for being obvious in view of Chen.

### **C. The Section 112, second paragraph Rejections**

Claims **1-25, 27-75 and 80-95** were rejected as being indefinite. In particular, the Final Action at paragraph 3 alleges that the phrases “a subsidizer different from the at least one merchant” and the “third party entity different from the merchant”, which appear in the independent claims, are indefinite. In addition, the term “third party entity” was deemed to be arbitrary and readily changeable, even though it was recognized that: “The common meaning of “third party” is an entity that is independent of some other first and second parties” (Final Action, paragraph 4).

The present claims pertain to methods and systems for allowing merchants to sell different products to different customers at different prices, wherein adjustments are made to the price of one or more of the products if the customer agrees to perform a qualifying action in return for receiving the price adjustment (see application, for example, at page 6, lines 21-26). In a restaurant oriented embodiment, a customer may have the choice of a 10% discount off of any of four entrees, or a five dollar discount, or a ten dollar discount off one of the entrees, which is dependent on which of three qualifying actions that the customer agrees to fulfill. In this example, each of the three qualifying actions is associated with a third party entity different from the restaurant-- a taxi service (customer agrees to take a taxi to the restaurant), a store (customer agrees to buy a particular brand of shampoo), and a department store (customer agrees to buy a sweater) (See application, page 19, line 27 to page 20, line 28). In view of this example, and several other examples set forth in the present application, Applicants respectfully submit that one skilled in the art would readily understand that each third party entity (or subsidizer) offering products or services is *different from* the restaurant (merchant) serving the entrees.

In addition, each of the independent claims **1, 56, 60, 69, 71, 75, 81 and 92-95** has been amended to make it clear that either the qualifying action (or the subsidy offer) *concerns a product of the subsidizer* (or *concerns a product of the third party entity*). Support for such changes can be found, for example, in the example described above (Application, page 19, line 27 to page 20, line 28). Thus, no new matter has been added.

Furthermore, each of new claims **96-106** depend on one of the independent claims **1, 56, 60, 69, 71, 75, 81 and 92-95**, and recites that the merchant is a restaurant (where applicable), and that the subsidizer (or third party entity) is at least one of an automobile dealership, a mortgage brokerage company, an investment company, an insurance company, a taxi service, a retailer, a department store, a magazine subscription company, a credit card provider, a telephone service provider or an internet service provider. Support for such dependent claims can be found, for example, in the specification on page 18, lines 17-23, and on page 19, line 27 to page 20, line 28. No new matter has been added.

Applicants respectfully submit that the amendments to independent claims **1, 56, 60, 69, 71, 75, 81 and 92-95** discussed above, and the addition of claims **96-106** make it clear that the merchant (restaurant) is a different entity than the subsidizer (third party entity) that provides the price adjustment (discount). It is also now clear that *the qualifying action concerns a product of*

*the subsidizer (or third party entity), or that the subsidy offer concerns a product of the subsidizer.* In the context of the claims, and in view of the examples disclosed in the specification, Applicants respectfully submit that one skilled in the art would fully understand, not only that each third party entity (or subsidizer) is *different from* the restaurant (merchant) serving the entrees, but also that the qualifying action (or subsidy offer) *concerns a product of the subsidizer (or third party entity).*

Applicants note that claims **2, 3, 5-7, 10-12, 14, 26, 27, 35, 38, 65-68, 76-80 and 82-91** have been cancelled, and thus the indefiniteness rejection as to these claims is now moot.

In view of the above amendments and remarks, we respectfully submit that independent claims **1, 56, 60, 69, 71, 75, 81 and 92-95** are definite as one skilled in the art would easily be able to discern the scope of these claims. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 112, second paragraph rejections of the pending claims.

#### **D. Section 102(e) Rejections**

Claims **1-18, 20-23, 27-71, 75 and 80-95** have been rejected as being anticipated by Chen. Consequently, independent claims **1, 56, 60, 69, 71, 75, 81 and 92-95** have been amended, and independent claims **65, 80 and 82** has been cancelled.

In particular, claims **1, 56, 60 and 92-95**, in addition to reciting that the plurality of products are associated with at least one merchant, and that the subsidy offer is associated with at least one subsidizer *different from* the at least one merchant, now also recite that the subsidy offer includes at least one qualifying action *that a customer must agree to perform to receive the price adjustment* and wherein the qualifying action *concerns a product of the subsidizer*. Similarly, independent claims **69, 71, 75 and 81** have been amended to make it clear that that the price adjustment is available upon completion of a qualifying action *that a customer must agree to perform to receive the price adjustment*, wherein the qualifying action *concerns a product of the third party entity*. Support for such changes can be found, for example, on page 19, line 27 to page 20, line 28; and on page 30, lines 19-21. No new matter has been added.

Pending claim **1** is illustrative of the present independent claims, and recites providing an indication of a plurality of products that each have an initial price and that are associated with at

least one merchant. The process includes providing an indication of an available price adjustment, and an indication of a subsidy offer being associated with at least one subsidizer different from the at least one merchant, wherein the subsidy offer includes a qualifying action *that a customer must agree to perform to receive the price adjustment*, and wherein the qualifying action concerns a product of the subsidizer. As discussed above, the present application contains numerous examples of qualifying actions of the third party (subsidizer) such as test driving a vehicle at an automobile dealership, shopping at a particular store, using a particular vending machine, using a specific credit card during a purchase, switching long distance telephone service providers, accepting a magazine subscription, and/or some combination of activities (See, for example, the application at page 18, lines 18-24). Such a process advantageously permits a merchant, such as a restaurant, to offer different prices to different customers for the same products (because a particular price for a product may depend on the subsidy and / or qualifying action), thereby allowing the customers to make purchasing decisions based on their own price sensitivity. Furthermore, the merchant may also receive a benefit from the completion of a qualifying action by a customer (see page 9, lines 17-26). The third party subsidizer benefits by gaining access to the merchant's customers for marketing opportunities (see page 10, lines 2-6), and the customers benefit because they get access to offers for products and / or items at reduced prices if they agree to complete or otherwise satisfy a qualifying action (see page 10, lines 7-14). Claim 1 has also been amended to recite *receiving an acceptance of the subsidy offer, and providing the price adjustment to the customer*.

In contrast, Chen is directed to methods and systems for reducing excess capacity of restaurants and other industries during off-peak hours. An auction system allows customers to bid for gift certificates that are redeemable at the businesses during the predetermined off-peak times (See Chen, Abstract; col. 1, lines 43-51; and col. 8, lines 19-31). In another aspect, Chen's system permits a user to enter an "incentive request" that may be processed by or for a restaurant to determine if a dining incentive should be issued to the customer. In another aspect, if an incentive is accepted, it may be issued to the customer without a paper certificate, for example, by storing the incentive information electronically with a payment processing system associated with the restaurant. In this case, a customer may provide payment information to receive the incentive, and when that payment information is input at the restaurant (i.e., a restaurant employee scans the customer's credit card to obtain payment for a meal that was served), then

the incentive can be retrieved and automatically deducted from the amount to be charged to that credit card number (Chen, col. 6, line 61, to col. 7, line 9). Each of these incentive schemes involves a discount provided by the restaurant and pertains only to the food dishes offered by the restaurant. Chen also discloses that item specific promotions could be offered that may be funded by the restaurant, or directly by a manufacturers or food and beverage suppliers. In his example, a customer who buys a bottle of red wine with a meal at the restaurant and pays with a credit card may be having his purchases tracked so that a manufacturer *could offer* that customer a 10% discount on another bottle of the *same* wine, or a competitor *could offer* a discount to the customer to try a similar red wine (Chen, col. 20, lines 3-13). But Chen does not teach or suggest offering a price adjustment for the plurality of products to a customer in exchange for that customer agreeing to perform a qualifying action that *concerns a product of the subsidizer*, and then *receiving an acceptance of the subsidy offer*, and *providing the price adjustment to the customer* (which pertains to the plurality of products, and not to the product of the subsidizer) as recited by pending claim 1.

Furthermore, independent claims **69 and 71** now recite *receiving a request from a customer utilizing a wireless device*, whereas independent claims **75 and 81** now recite *receiving a request from a customer utilizing a wireless device in a restaurant*. Support for such changes can be found, for example, on page 11, lines 20-26 of the specification. Thus, no new matter has been added. The applicants respectfully submit that Chen fails to teach or suggest such operation.

Accordingly, since Chen fails to teach or even suggest offering a price adjustment for one or more products (or items in a restaurant) to a customer in exchange for that customer agreeing to perform a qualifying action that *concerns a product of the subsidizer* (or *that concerns a product of a third party entity*) as generally recited by the independent claims **1, 56, 60, 69, 71, 81 and 92-95**, nor teach or suggest *receiving a request from a customer utilizing a wireless device* as generally recited by independent claims **69, 71, 75 and 81**, none of these independent claims are anticipated by Chen. Furthermore, since each of pending claims **4, 8, 9, 13, 15-25, 28-34, 36, 37, 39-55, 57-59, 61-64, 70, 72-75 and 96-106** depends upon either of claims **1, 56, 60, 69, 71, 81 or 92-95**, these claims are not anticipated for at least the same reasons.

In view of the above amendments and remarks, Applicants respectfully assert that claims **1, 4, 8, 9, 13, 15-25, 28-34, 36, 37, 39-64, 69-75, 81 and 92-106** are patentably distinct over Chen, and thus request withdrawal of all of the 35 U.S.C. §102(e) rejections.

**E. Section 103(a) Rejection**

Claims **19, 24, 25, 72-74 and 72-74** were rejected as being obvious in view of Chen.

Pending dependent claims **19, 24, 25 and 72-74** all concern verifying accuracy of a record, or receiving a verification request, or verifying the accuracy of a price associated with at least one item in a verification request. The Examiner admits that Chen does not teach verification (See paragraph 11 on page 3). However, as support for this rejection, the Final Action recites:

“Because verification is common sense (“measure twice, cut once”) and easy to achieve (Waiter, will I get the discount if I order this item?), it would have been obvious... to add price verification to the teachings of Chen et al.”. (Final Action, paragraph 11 on page 3).

Appellants respectfully assert that such an assertion, without more, does not constitute clear and particular findings supported by actual and substantial evidence of record that could support such an obviousness rejection. In addition, no evidence has been provided in support of any motivation to provide for any such features in Chen. Accordingly, no *prima facie* case of obviousness has been made for claims **19, 24, 25 and 72-74**, and request withdrawal of the Section 103 rejection.

Moreover, claims **19, 24, 25 and 72-74** directly or indirectly depend on at least one of independent claims **1 and 71**, which are patentably distinct from Chen for the reasons explained above. Consequently, claims **19, 24, 25 and 72-74** should be allowable for at least the same reasons.

In view of the above remarks, Applicants respectfully request withdrawal of the rejections based on 35 U.S.C. 103(a).

**F. Conclusion**

At least for the foregoing reasons, we respectfully submit that all of the claims are in condition for allowance, and the Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this Amendment or the present application, the Examiner is cordially requested to contact Stephan Filipek at telephone no. 203-461-7252 or via electronic mail at [sfilipek@walkerdigital.com](mailto:sfilipek@walkerdigital.com).

**G. Peteion for Extencsion of Time to Respond and Fees and Other Payments**

Applicants hereby petition for a two-month extension of time with which to respond to the Final Action. Please charge the fee for this petition to our Deposit Account No. 50-0271, along with the fees pursuant to 37 C.F.R. 1.17(e) for this request for continued examination, and to cover any fees that may be required to cover costs associated with filing additional claims in excess of those already paid for.

Applicants do not believe that any other fees are due. But if a fee should be necessary to continue prosecution of the present application, please charge any such required fee to our Deposit Account No. 50-0271, and credit any overpayment to Deposit Account No. 50-0271.

Respectfully submitted,

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Date

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